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| 09/824,878 | 04/04/2001 | Mihai Rasidescu | P 276825 RP-00208-US4 | 3371 |

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EXAMINER

CULBRETH, ERIC D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3616

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,878

Applicant(s)

SATO, KOICHI

Examiner

Eric D Culbreth

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-136 is/are pending in the application.
- 4a) Of the above claim(s) 18, 20, 41, 43, 66, 69, 80-82, 93, 97, 124 and 128 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 111-115 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 96 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 April 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continuation of Disposition of Claims: Claims rejected are 1-17,19,21-40,42,44-65,67,68,70-79,83-92,94,95,98-110,116-123,125-127 and 129-136.

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4/25/03 have been disapproved because the specific changes proposed to the drawings were not marked in red; hence, it is difficult to see specifically which changes have been made (for example, although page 26 of the remarks filed 4/25/03 state that 866 was changed to 865 in the drawings, but it is not seen in the proposed drawings filed 4/25/03 apparently because it was not shown in red). A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

2. The drawings are objected to because of the following informalities. Because the drawing changes filed 4/25/03 were not approved, the following objections to the drawings remain. The other objections to the drawings raised in the examiner's First Office Action have been overcome by applicant's remarks. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

- a. Reference numeral 900 (page 4, line 3 from the end) is not on the drawings.
- b. In Figures 5 and 13 lines "A-A" and "B-B" should be "18A-G – 18A-G", as section lines should be named for the figures they represent.
- c. Reference numeral 12''' (page 17, paragraph [0064] is not on the drawings.

Claim Rejections - 35 USC § 112

3. Claims 46-47 and 102-103 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In these claims, it is not clear what is meant by “semi-independent” and “non-independent” (the latter is a negative limitation). Regarding applicant’s remarks on pages 28-29 of the remarks filed 4/25/03 that the terms are clear from paragraph [0095] of the specification and that negative limitations are acceptable as long as the boundaries of the patent protection sought are set forth definitely (MPEP 2173.05), these arguments are not persuasive because paragraph [0095] only mentions the terms “semi-independent” and “non-independent” and does not explain what they mean and because, as noted in applicant’s claims 46 and 102, there are apparently “semi-independent” suspensions; hence it is not clear if the limitation “non-independent” suspension is infringed by a “semi-independent” suspension.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 50 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Rasidescu et al (U.S. Patent 5,975,624, of record, cited by applicant).

In Figure 15, Rasidescu et al discloses (claim 50, from which claim 52 depends), a frame for an ATV comprising a support module as broadly disclosed (supporting the suspension) with a

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central opening between members 22 including first and second longitudinal frame members 22, 22 interconnected by forward and rearward cross members, first and second suspension points 25, 99 associated with one of the members 22, and each of members being a single longitudinal beam. Regarding claim 52, as can be seen at the forward end of beams 22, each beam is tubular.

6. Claim 119 is rejected under 35 U.S.C. 102(b) as being anticipated by Itoh et al (of record).

Itoh et al discloses a first frame member at 43 in Figure 11b, a second frame member along the bottom of the frame in Figure 11b (the purely horizontal part), and at least a first cross member (the angled portion at 42 and head tube 2) and a second cross member (the purely vertical part to which portion 53 is connected) extending between the first and second members to define a closed perimeter with an engine receiving space, with each member having a rectangular cross section (the forward cross member having a rectangular cross section at least in the angled part).

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-2, 4-6, 9, 17, 19, 21-22, 50-51, 53-57, 62, 64, 67, 107-110, 125-127, 129, 131, and 133-135 as well as 121-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardi in view of Sheffer (both of record).

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Bernardi discloses a frame member 10 with suspension mounting points for outboard wheels 18, 50 in Figure 1 (the brackets above and below part 19 being the first suspension mounting points, the bracket on frame 10 to which arms 22 are mounted having the second suspension mounting points), the frame 10 extending from the first to the second suspension mounting point. Sheffer discloses as an object of the invention providing a motorcycle or the like that traverses rough terrain (column 1, lines 25-35) with an upper platform or frame member 18, lower frame member or floor 25, first cross member 24 and second cross member 22 extending between the frame members to form a closed perimeter with an engine receiving space, suspension mounting points associated with at least one of the frame and cross members (where brackets 90 and 132 are mounted), and at least one of members 18, 25 along the frame centerline from one mounting point to the other. At least one member 18 consists of essentially of a single beam. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bernardi to include an engine and frame arrangement such as that taught by Sheffer in order to lower the center of gravity, steer and guide at any rate of speed, and use a minimum number of parts in construction (Sheffer, column 1, lines 40-55) (claims 1-2, 21, and 50). As Sheffer is for motorcycles, bicycles and like vehicles that encounter rough terrain, it would include vehicles with outboard wheels such as Bernardi's, which is an all terrain vehicle (for off road, as per the last three lines of Bernardi's abstract). Sheffer's mounting points are on the lower longitudinal frame member 25 in the combination, which would be a teaching to place the first and second outboard wheel suspension points on the surface of the lower frame member (claims 4 and 50). Similarly, in the combination floor 25 is of rectangular cross section (claims 5-6). Also in the combination Sheffer's members 18 and 25 are vertically aligned (claim 9) and

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rear suspension mounting structure (Bernardi's mountings for the rear springs) would be rigidly mounted to the outboard wheel suspension mounting points on the frame in keeping with Sheffer's rear suspension mounting structure 132 rigidly mounted to one of the suspension mounting points (claim 19). Noting claim 17, in the combination Sheffer's frame member 25 is bent toward frame member 18 to form cross member 24. regarding claims 53-54, Sheffer in the combination teaches first and second suspension points at 28, 102 with frame member 18 extending between them. Regarding claim 67, in the combination Bernardi's swing arm 22 would be mounted to rigid structure such as Bernardi's upside L-shaped bracket on frame 10 or rigid structure 102 mounted on a suspension point under bracket 102, the mounting point in the combination being within the central opening adjacent cross member 22 and second frame member 25 of Sheffer. All the features of claims 107-110 have been addressed in the rejections above. In regard to claims 129, 131, and 133-134, Bernardi, the primary reference teaches pivot axes at suspension points above and below member 19 with longitudinal axes parallel to the longitudinal centerline of the frame. Finally, in regard to claim 135, Bernardi, the primary reference, teaches the axis of rotation of front wheels 18 as between the ends of frame 10. In the combination Sheffer's forward and rearward cross members are a single beam (claim 51). The features of claims 55-57, 121-123 and 125-127 have been discussed in various rejections above. Regarding claim 62, Bernardi, the primary reference, teaches footrests that meet the claim. In the combination Sheffer's frame and cross members are each a single beam (claim 22). In the combination Sheffer's forward portion of the upper frame member is bent generally downwardly and abuts/connects to the lower frame member to form the first cross member (claim 64).

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9. Claims 10-15 and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardi in view of Sheffer as applied to claims 1 and 50 above, and further in view of Tsukahara et al (of record).

Tsukahara et al discloses the forward portion of a longitudinal frame member bent upwardly from the horizontal in front of the area supporting the engine (the support module as broadly recited). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bernardi and Sheffer to include the forward portion of the lower frame member bent upwardly as taught by Tsukahara et al in order to support a suspension (column 2, lines 26-39 of Tsukahara et al). The angle of the horizontal is an obvious matter of design choice (claims 14-15 and 59-60), as there is no stated reason or particular purpose in the specification for the particular angles given and the invention would appear to work just as well with angles similar to that of the prior art. In the combination (claims 10-12) Tsukahara et al teaches upper and lower longitudinal frame members and cross members of identical shape and size in cross section with a uniform cross section throughout a length thereof.

10. Claims 7-8, 16, 61, 63 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardi in view of Sheffer as applied to claims 5, 50 and 55 above, and further in view of Itoh et al (of record).

Itoh et al teaches a seat rail 4 that is a central trough in an upper frame member (claim 63) and laterally extending members 22 on the upper frame the connect the seat. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bernardi and Sheffer to include seat mounting structure such as taught by Itoh et al in order to

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mount the seat to the upper frame member in a lower position on the vehicle, hence further lowering the center of gravity. Regarding claims 7-8 and 70, Itoh et al teaches an ellipsoid shape in Figure 13 as a structural equivalent alternative to a rectangular cross section in the combination. Making the cross section oval would be an obvious matter of design choice, as the specification gives no stated purpose or particular reason for an oval shape, and such an oval shape would appear to work just as well as Itoh et al's elliptical shape.

11. Claims 116 and 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Rasidescu et al '624.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al (frame 10 with central opening for engine and single tube 11 forming at least one of connected frame members 11, 12) to include suspension mounting points associated with the support module as taught by Rasidescu et al's mounting points 24, 99 in order to conventionally suspend the wheels.

12. Claims 117-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Rasidescu et al as applied to claim 116 above, and further in view of Itoh et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Rasidescu et al to include rectangular cross sections for the upper and lower frame members as taught by Itoh et al in order to improve bending rigidity.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al in view of Matsubayashi et al.

Itoh et al teaches in Figure 11b a frame formed of a single beam tubular structure with upper and lower frame members and cross members made of a single beam. However, Itoh et al is for an on-road motorcycle and does not teach first and second outboard wheels suspension mounting points associated with some member of the frame. Matsubayashi et al discloses in column 1, lines 10-25 that motorcycle like frames are used for four wheel all terrain vehicles. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Itoh et al to include suspension mounting points for a outboard wheels as taught by Matsubayashi et al in order to enable the vehicle to go off road. In the combination the suspension mounting points for Itoh et al's wheels (i.e., the ends of the head tube 2 and the rear shock absorber mounting point on the frame in Figure 10) would be the outboard wheel suspension mounting points on at least one of the frame members as broadly recited (recited in claim 1 from which claim 3 depends).

14. Claims 23-27, 28-29, 32, 36-38, 42, 44, 46-47, 71-72, 74-79, 86, 90-91, 94, 100, 102-103, and 105 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer.

Matsubayashi et al teaches cross members 12b, 12f, second frame member 12d, 12d' and longitudinally centered beam 11 forming an engine receiving space, but does not teach suspension mounting points associated with one of the frame members. Portion 12d is bent

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upwardly from horizontal (Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al to include suspension mounting points such as taught by Sheffer at 90 and 132 in order to conventionally mount a suspension to the vehicle to ease shocks and travel over bumps. As Matsubayashi et al, the primary reference, teaches outboard wheels, the suspension mounts in the combination would be outboard wheel suspension mounts, and Matsubayashi et al is a vehicle designed for all types of terrain (an ATV) (claim 23). The front portion of Matsubayashi et al's lower frame 12d is angled upwardly, and the particular angle is an obvious matter of design choice as described in rejections above (claims 36-38). Matsubayashi et al teaches a singular tubular beam 11 (claims 24-25). Sheffer in the combination teaches the upper and lower frame members and front and rear cross members consisting of a single beam (claims 26-27). Regarding claims 28-29 and 32, in the combination Sheffer's mounting points for brackets 90, 132 are on the upper frame member, and the cross section of each of Sheffer's frame members has a greater width than height. Sheffer's upper and lower frame members are vertically aligned in the combination. In the combination Sheffer's rear bracket 132 is fixedly mounted at a suspension mounting point (claim 42), and (claims 46-47) in the combination Sheffer's suspension is semi or non independent as best understood because of torsion bars 94, 122 connected to the front and rear arms as well as to floor 25. Regarding claims 71-72 and 90-91 in the combination Sheffer teaches the upper and lower frame members and front and rear cross members being beams and pivot structures at 102, 28 in the central opening. Trailing arms 106 of Sheffer in the combination would carry Matsubayashi et al's outboard wheel assemblies as broadly recited. In regard to claims 73-75 Matsubayashi et al's beam 11 is a closed tubular structure forming the

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single beam, and in the combination the suspension points 28 and 102 of Sheffer would be on the lower frame surface of Matsubayashi et al, with the lower frame extending between them, mounting an outboard wheel assembly. In the combination Sheffer teaches forward and rear suspension subsystems 88, 130 on outboard wheel suspension mounting points 90, 132 as broadly recited (claim 44; the wheel would be outboard in keeping with Matsubayashi et al, the primary reference). Regarding claims 100, 102-103 and 105, Sheffer teaches in the combination forward and rearward suspension assemblies 94, 122 that are semi- or non-independent as best understood and are connected to the lower frame member 25. Sheffer in the combination also teaches brackets 102 within the central opening mounting swing arms (claim 94). In regard to claims 77-79, Matsubayashi et al's engine 50 is connected at least to the upper frame member at 35, and in the combination Sheffer's aligned upper and lower frame members are bent at their ends to form the cross members. In the combination Sheffer's upper frame member is bent downward and abuts/connects to the lower frame member to form the first cross member (claim 86).

15. Claims 33-35, 130, 132 and 136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer as applied to claims 23 and 71 above, and further in view of Tsukahara et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Sheffer to include longitudinal pivots for the one of the outboard wheel assemblies and the axis of rotation of the front wheels intermediate the frame ends as taught by Tsukahara et al's brackets 3, 4 with longitudinal pivot axes mounting the front

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wheels with their rotation axes behind the front of the frame as seen in Figure 3 in order to allow the frame to better support the front wheel suspensions (column 2, lines 26-39) (claims 130, 132 and 136). Regarding claims 33-35 in the combination Tsukahara et al's frame members are of uniform cross section throughout a length of each cross and longitudinal frame member, as well as identical in cross section size and shape.

16. Claims 30-31 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer as applied to claim 29 above, and further in view of Itoh et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Sheffer above to include elliptical/oval cross section frame members as taught by Itoh et al in order to alternative equivalent shapes in the art, as Itoh et al teaches ellipses/ovals can be used in place of rectangular cross sections on frames. Also in the combination Itoh et al teaches (claims 39-40) laterally extending seat connecting members 22 and Sheffer teaches lower frame member 25 bent toward upper frame member 18 at an end to form cross member 24.

17. Claims 45, 48-49, 92, 95, 98, 101, and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer as applied to claims 44, 71, 94 and 100 above, and further in view of Bernardi.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Sheffer to include a fully independent suspension as

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taught by Bernardi in order to better cushion shocks to the vehicle (claims 45 and 101). Sheffer in the combination teaches the swing arm suspensions connected to the exterior of the lower frame member at 102 and 28 (claims 48-49 and 95 and 104), and Bernardi in the combination teaches front a-arms that would be attached to the lower frame by mounts (claims 92 and 98).

18. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer as applied to claim 50 above, and further in view of Patin (of record).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Sheffer to include a second support structure rearward of the support module in view of Patin, who teaches two vertical posts supporting the upper frame member for the seat, in order to support the seat with a second support at an alternative known equivalent location to Matsubayashi et al's second support at 19.

19. Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardi in view of Sheffer as applied to claim 67 above, and further in view of Hara (of record).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bernardi and Sheffer to include brackets that mount both the swing arm and engine in view of Hara's brackets 25-1, 25-2 which mount swing arms 13 at holes 27 and the engine at 25a in order to minimize parts.

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20. Claims 73, 83-85, 99 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer as applied to claim 71 above, and further in view of Itoh et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Sheffer to include beams formed of a tubular structure as taught by Itoh et al in order to make the frame stiffer and to laterally extending connecting members on the upper frame member in order to mount a seat conventionally (claims 73 and 83). Regarding claims 84 and 85, Itoh et al teaches in the combination footrests below part 26 as well as a trough for a seat in the upper frame member. Itoh et al also teaches an elliptical profile in section in the combination, and Matsubayashi et al's steering column receiver 40 extends above the upper frame member and connects to the front wheels (claims 99 and 106).

21. Claims 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al in view of Sheffer as applied to claim 71 above, and further in view of Patin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matsubayashi et al and Sheffer to include a second support behind the rear cross member as taught by Patin in order to better support the seat using an alternative arrangement to Matsubayashi et al. Regarding claims 88-89, in the combination Patin teaches a differential in frame 8 that would be attached to a rear drive (the differential in the combination) through a horizontally extending opening in the rear cross member 22 inasmuch as applicant's opening (i.e., the opening would have a horizontal dimension to it).

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Allowable Subject Matter

22. Claims 111-115 are allowed.

23. Claim 96 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

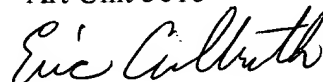
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D Culbreth whose telephone number is 703/308-0360. The examiner can normally be reached on Monday-Thursday, 9:30-7:00 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 703-308-2089. The fax phone numbers for the organization where this application or proceeding is assigned are 703/746-3508 for regular communications and 703/308-2571 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Eric D Culbreth
Primary Examiner
Art Unit 3616



7/12/03

ec
July 12, 2003